

**REMARKS**

Please reconsider the application in view of the above amendments and the following remarks.

**Domestic Priority under 35 U.S.C. § 119(e)**

Applicants request the Examiner to acknowledge the Applicants claim to domestic priority to U.S. Provisional Application No. 60/055,608 filed on August 14, 1997 (hereafter “provisional application”). Applicants also request the Examiner to confirm that the translation of the provisional application was originally received on January 2, 1998, and subsequently re-submitted (at the request of the USPTO) on February 18, 1998.

**Disposition of Claims**

Claims 79-81, 83-92 and 95-98 were pending in the referenced application. Claim 84 has been cancelled by this reply without prejudice or disclaimer. Further, claims 99-101 have been added by this reply. With respect to the pending claims, claim 79 is independent. The remaining claims depend, directly or indirectly, from independent claim 79.

**Claim Amendments**

Claims 79 and 83 has been amended by this reply. Further, new claims 99-101 have been added by this reply. Support for the aforementioned claim amendments and new claims may be found, for example, on pages 2, 3, 5, and 9 as well as Figure 4B of the provisional application and

on pages 41-47 of the application as filed. No new matter has been added by any of the aforementioned amendments.

### **Rejections Under 35 U.S.C. §102(e)**

Claims 79-80, 90, and 98 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,486,895 ("Robertson"). To the extent that this rejection applies to amended claim 79, the rejection is respectfully traversed.

As previously stated, claim 79 is directed to a method for creating an electronic book. The method includes, in part, (i) obtaining pages of the electronic book (*i.e.*, electronic documents); (ii) organizing the pages in a first order; (iii) obtain an additional page (*i.e.*, the first additional electronic document), which includes a computer program configured to change the current order of the pages in the electronic book; (iv) executing the computer program to modify the order of the pages in the electronic book to obtain a new order of pages (*i.e.*, the second order); and (v) after the execution of the computer program the location of at least one page in the electronic book is different than its corresponding location prior to the execution of the computer program.

Further, by way of this reply, claim 79 has been amended to clarify that "the relative location of at least one of the first plurality of documents in the first order is different than the relative location of the at least one of the first plurality of documents in the second order." For example, if the first order of electronic documents is A, B, C, D, E and the second order of electronic documents was B, C, D, E (*i.e.*, electronic document A is removed) there is no difference in the relative location of the remaining documents. However, if the second order is A, C, D, B, E, then the relative location of at least B is different between the first order and the second order. Said

another way, B which was originally adjacent to both A and C in the first order is now adjacent to D and E.

Turning to the rejection of the claims, for anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. *See* MPEP § 2131. The Applicants respectfully assert Robertson fails to disclose all limitations of independent claim 79.

Specifically, Robertson fails to disclose re-ordering the pages. As previously discussed, claim 79 requires that the computer program re-order the first plurality of electronic documents (*i.e.*, re-ordering from the first order to the second order). Rather, Robertson merely discloses “ruffling” pages. Applicants assert that the ruffling of pages is not equivalent to re-ordering the pages. Rather, ruffling allows the user to sequentially navigate through the pages without any reorder.

Moreover, in response to the Examiner’s assertion that modifying the order covers “including or removing a cover from the book” Final Action mailed January 28, 2008, p. 13. Applicants have clarified claim 79 to explicitly recited that there is a relative change in location of at least one the electronic document in the second order (when compared with the first order). In view of this amendment, the Examiner’s assertion that removing or including a cover from a book is within the scope of creating a second order is now moot as including or removing a cover does not change the relative location of the electronic documents in the book. Moreover, reordering requires that the order of the electronic documents (*i.e.*, the pages are encountered in a different sequence during a subsequent sequential navigation after the reorder) while removing a cover page does not change the order of the remaining pages.

Accordingly, amended independent claim 79 is patentable over Robertson. Pending dependent claims are patentable over Robertson for at least the same reasons as amended independent claim 79. In view of the above, withdrawal of this rejection is respectfully requested.

### **Rejections under 35 U.S.C. § 103**

Claims 81, 83-89, 91-92, and 95-97 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Robertson in view of the article entitled “Laura Lemay’s Web Workshop Microsoft FrontPage 97” (“Lemay”) and U.S. Patent No. 6,473,752 (“Fleming”). Claim 84 has been cancelled by this reply. To the extent this rejection applies to the pending claims, the rejection is respectfully traversed.

At the outset the Applicants assert that Fleming is not prior art to at least claims 83, 85, 86, 87, 88, 89, 91, 97, and 98. Specifically, the referenced application claims priority to U.S. Provisional Application No. 60/055,608 filed on August 14, 1997 (hereafter “provisional application”). The provisional application discloses subject matter covering the aforementioned claims on at least the following pages:

- Claim 83 – page 2 of the provisional application;
- Claim 85 – pages 2, 6, and 10 of the provisional application;
- Claims 86 and 87– page 2, 3, and 9 of the provisional application;
- Claims 88, 89 – pages 2, 3, 5, 6, 9, and 10 of the provisional application;
- Claim 91 – pages 6 and 7 of the provisional application;
- Claim 97 – page 6 of the provisional application; and
- Claim 98 – page 3 of the provisional application.

Fleming was filed on December 4, 1997 and, accordingly, is not prior art with respect to the above claims. Accordingly, this rejection is not proper.

With respect to claims 81, 92, and 96, the Examiner has admitted that Robertson fails to teach or suggest the limitations in the aforementioned claims. *See* Final Action mailed January 28, 2008, pp. 6, 12, and 13. Instead, the Examiner has relied upon Lemay and Fleming. Applicants assert that Lemay fails to teach or suggest that which Robertson lacks for at least the reasons presented in the Response mailed on November 7, 2007. Further, Applicants assert that Fleming also fails to teach or suggest that which Robertson and Lemay lack as evidenced by the fact that Fleming is only relied upon to teach recoding document usage (*See* Final Action mailed January 28, 2008, p. 7). In view of the above, claims 81, 92, and 96 are patentable over the cited prior art. In view of the above, withdrawal of this rejection is respectfully requested.

#### **New Claims**

New claims 99-101 have been added by this reply. As discussed above, support for the new claims may be found, for example, as follows:

- Claim 99 – pages 3 and 9 of the provisional application;
- Claim 100 – pages 2 and 9 of the provisional application; and
- Claim 101 – pages 3 and 9 of the provisional application.

Applicants assert that none of the cited prior art, whether considered separately or in combination, teaches or suggests all the limitations of the newly added claims. Accordingly, favorable action in the form of a Notice of Allowability is respectfully requested.

**Conclusion**

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 17363/002001).

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